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10/070,506

03/17/2002

Guy Marcel Charles Claude Breger

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06/14/2004

DRINKER BIDDLE & REATH
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/070,506

Applicant(s)

BREGER ET AL.

Examiner

Stephen R Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's election in the paper filed March 12, 2004 is acknowledged. However, the lack of unity requirement is hereby withdrawn.

The disclosure is objected to because of the following informalities: On page 2 line 3 reference letter "G" is not shown in the drawings, on page 6 line 20 reference numeral "22" should be --23--, on page 9 line 13 "arrows" should be singular, reference numeral "11A" listed on page 9 line 21 is not shown in Figure 3, on page 11 line 27 reference numeral "S1" should be --S2--, on page 11 line 30 reference numeral "24C" should be --14C--, on page 12 line 4 reference numeral "9C" is not shown in Figure 7, on page 12 line 7 "markers 14C, 24C" is inconsistent with the previous terminology "motifs 14C, 24C", and on page 12 line 9 reference numeral "25D" should be --25--. See Figure 8.

Appropriate correction is required.

The drawings are objected to because Figures 1A - 1C should be labeled as --Prior Art--. See page 5 lines 4 - 5 in the specification. Reference letter "G", listed on page 2 line 3, is not shown in the drawings. Two of the three reference numerals "21A", shown in Figure 3, should be --23A--. See page 9 lines 20 - 21. Reference numeral "11A", listed on page 9 line 21, is not shown in Figure 3. Reference numeral "9C", listed on page 12 line 4 is not shown in Figure 7. In Figure 7 preprinted motif 14C is shown on the wrong side of the film 1C. The motif must be located on the underside of the film 1C in order to be transferred to strip 2C.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where

Art Unit: 2854

necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1 - 24 are objected to because of the following informalities:

In claim 1 line 3 "the transfer station" lacks proper antecedent basis.

In claim 5 line 1 there is no antecedent basis for "a second detector" since there is no previous recitation of a first detector. Note that claim 5 depends directly from claim 1.

In claim 8 the structure for printing the motifs should be positively recited with respect to the transfer cylinder, not the actually printed motifs. This could be corrected by reciting, for example, that the transfer cylinder has successive elements with an offset.

In claim 9 line 2 "a cylinder" is a double recitation of the same in claim 8 lines 1 - 2.

In claim 10 line 2 "are" should be deleted.

In claim 13 line 4 "the tool" lacks proper antecedent basis. In lines 16 and 18 "the transfer means" and "the cutting means" lack proper antecedent bases. In line 17 "plane" should be presumably be --plate--.

In claim 16 line 3 "the transfer strip" lacks proper antecedent basis.

In claim 19 line 4 "the tool" lacks proper antecedent basis. In line 23 "the detection means" lacks proper antecedent basis. In the last line "the intake and outlet cylinder" lacks proper antecedent basis.

Applicant should carefully review all the claims for any additional errors.

Appropriate correction is required.

Claims 1 - 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of independent claims 1, 13, and 19 line 1 “in particular gilding” renders the scope of the claims indefinite since it cannot be accurately determined if the claims require gilding.

In claim 6 the film drive and strip drive means operating “continuously” contradicts the recitations in claim 1 lines 9 - 11 that the drives feed the film and strip in “step[s]”.

In claim 14 the film drive and strip drive means operating “continuously” contradicts the recitations in claim 13 lines 7 and 19 that the film and strip are immobilized.

In claim 19 lines 16 - 19 the recitation of the film and strip being driven at the same peripheral speed during the transfer process contradicts the recitation in lines 7 - 8 that the strip is immobilized during the transfer.

Claim 20 is vague and indefinite for the same reasons stated above with respect to claim 14.

Overall, the claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. For example, note that claims 10 - 12 do not properly limit the structure of the system and the indeterminate recitations of “to be” in claims 13 and 19 line 2.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2854

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Stuart et al. (US 6,387,201). Stuart et al. teach means (292, 358) for driving a transfer film (502), means (274, 340) for driving a receiving strip (500), a transfer station (104) having transfer means (120), and control means (column 16 lines 5 - 16) for driving the film by a first step (I) corresponding to the motif and driving the strip by a second step (P) corresponding to the product. See the entire document of Stuart et al., in particular, column 11 line 21 - column 12 line 19, column 13 line 21+, and Figures 7 and 9 - 11. Note that Stuart et al. contemplate a single transfer station by utilizing the terminology “if” and “may” when referring to a second transfer station. See column 3 lines 56 - 59 and column 4 lines 15 - 16 and 54 - 55 of Stuart et al., for example. Accordingly, the first and second steps would be equal to a single motif (I) and product (P).

With respect to claim 3 note the at least one transfer element (558, 560) mounted on a rotary element (120).

With respect to claim 6 note that both drive means are operated step by step.

Claims 17, 18, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al. (US 4,869,767). Robinson et al. teach a product comprising a strip (33) having either an antenna (column 4 line 50) or a printed circuit (column 4 line 44). It is noted that product claims 17, 18, 23, and 24 are drawn solely to the product and are independent of the systems of claims 13 and 19 used to manufacture the product.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart et al. in view of Boswell (5,674,580). Stuart et al. do not teach a transfer element operated by a jack. Boswell teaches a transfer element (28) operated by a jack (27). See column 4 line 4+ of Boswell, for example. It would have been obvious to one of ordinary skill in the art to provide the system of Stuart et al. with a flat transfer element and jack in view of Boswell to provide an intermittent transfer system. With respect to claim 13 Stuart et al. further teach cutting means (column 10 lines 31 - 35). With respect to claim 14 note the comments above with respect to claim 6.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart et al. in view of Nyfeler et al. (US 5,207,855). Stuart et al. do not teach first and second detectors to control the movement of the film and strip. Nyfeler et al. teach first (37) and second (38) detectors to control the feed movement of a strip (1) and film (4). See column 7 line 6+ of Nyfeler et al. It would have been obvious to one of ordinary skill in the art to provide the system of Stuart et al. with first and second detectors in view of Nyfeler et al. so as to more accurately control the movement of the strip and film by detecting actual markings on the strip and film.

Claims 7, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart et al. in view of Aindow et al. (WO 96/37368). Stuart et al. do not teach a plurality of film drive means or a transfer cylinder for printing successive motifs with an offset. Aindow et al. teach a

Art Unit: 2854

plurality of film drive means (150) disposed in parallel and a transfer cylinder (102) having successive motif elements (4) offset laterally across the transfer cylinder. See page 2 lines 34 - 35 and page 5 lines 14 - 22 of Aindow et al., for example. It would have been obvious to one of ordinary skill in the art to provide the system of Stuart et al. with a plurality of drive means and successive offset motif elements in view of Aindow et al. so as to print laterally spaced motifs across the strip. With respect to claim 10 the recitation that the transfer elements are “designed to apply” polychromatic motifs, holographic motifs, and zones does not limit the structure of the transfer element.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart et al. in view of Boswell as applied to claims 2, 13, and 14 above, and further in view of Aindow et al. Neither Stuart et al. or Boswell teach a plurality of film drive means. Aindow et al. teach a plurality of film drive means (150) disposed in parallel. See page 2 lines 34 - 35 and page 5 lines 14 - 22 of Aindow et al., for example. It would have been obvious to one of ordinary skill in the art to provide the system of Stuart et al., as modified by Boswell, with a plurality of drive means so as to print laterally spaced motifs across the strip.

Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boswell. Boswell teaches a product comprising a strip (20) having holographic motifs (column 4 lines 56 - 60) and zones “intended to permit” binary recordings. The broad recitation of “intended to permit” does not positively recite a binary recording. Boswell further teaches that the strip may have printed motifs (column 3 lines 37 - 41 and 48 - 53). It is notoriously conventional in the art to provide polychromatic (multicolor) motifs for aesthetic purposes. It would have been obvious to one of ordinary skill in the art to provide the strip of Boswell with a

Art Unit: 2854

polychromatic motif to achieve a more aesthetic multicolor image. It is noted that claims 16 and 22 positively recite each of the polychromatic motif, holographic motif, and zones permitting binary recording. It is further noted that claims 16 and 22 are drawn solely to the product and are independent of the systems of claims 13 and 19, respectively, used to manufacture the product.

Claims 19 - 21 cannot be examined relative to the prior art at this time due to the inherent conflict within the claim of immobilizing the strip during transfer and controlling the drive of the strip and film to have the same speed as the peripheral speed of the transfer element during transfer.

Claims 9, 11, and 12 would be allowable if rewritten to overcome the objections and rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art of record does not teach transfer elements distributed around a cylinder in an offset arrangement by an inclined plane.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

SRF
June 9, 2004



STEPHEN R. FUNK
PRIMARY EXAMINER